IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Cathy Liu	Confirmation No. 8675
Serial No. :	09/832,098	Examiner: Heather D. Gibbs
Filed:	April 11, 2001	Art Unit: 2625
For:	IMAGE SCANNING SYSTEM AND METHOD FOR SCANNER	
Date:	June 13, 2007	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

This review is requested for the reason(s) stated on the attached sheet(s). Note: no more than five (5) pages may be provided.
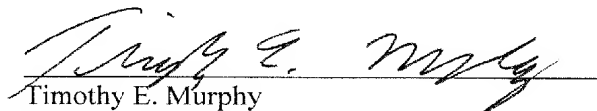
I am the:
- ☐ applicant/inventor
- ☐ assignee of record of the entire interest
    See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed)
- ☒ attorney or agent of record
- ☐ attorney or agent acting under 37 CFR 1.34

Total of 2 forms is submitted.

Customer No. 20575

Respectfully submitted,

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

The Final Office Action does not comply with MPEP § 706.07(a) because the Examiner applied new grounds for rejection that were not necessitated by amendments to the claims

In the Final Office Action dated 19 April 2007, the Examiner introduced new grounds of rejection for claim 1. Specifically, the Examiner combined Xu (US Pat. No. 6,763,141, new art) with the admitted prior art to render the claim feature "a preset calibration parameter" obvious. *See* Final Office Action paragraph 4. MPEP § 706.07(a) states that "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." In a submission dated 26 March 2007, the applicant amended claim 1 to remove formatting elements; the substance of claim 1 was not changed. Specifically, no words in the claim were removed, added, or modified; only bulleting letters were removed. Consequently, the amendments to claim 1 could not have necessitated new grounds for rejection. The Final Office Action introduced new grounds of rejection for claim 1 (the Xu reference) and stated that "Applicant's amendment necessitated the

new ground(s) of rejection"; but the Applicant's amendment was only form and not substance and so could not have necessitate new grounds of rejection. Therefore, the Final Office Action dated 19 April 2007 does not comply with MPEP § 706.07(a).

The Final Office Action does not comply with MPEP § 706.07 because the Examiner did not adequately rebut the Applicant's arguments for patentability

In the Final Office Action dated 19 April 2007, the Examiner reiterates the rejections of claims 2-7 as unpatentable over the admitted prior art in view of Wieloch (US Pat. No. 5,764,023). The Examiner's position is that Wieloch teaches "a control module having a read only memory (ROM) for storing a preset calibration parameter and using the stored calibration parameter to perform compensation and calibration for the captured image (Col. 7 Lines 52-66)." *See* Final Office Action paragraph 6. It should be noted that Wieloch concerns a "Motor Controller with Circuit Interrupter and Method for Interrupting Power to a Motor Controller" and has nothing to do with image scanning. *See* Wieloch, Title. Further, the word "image" is not found anywhere in Wieloch; and so Wieloch could not teach compensation and calibration for the captured image as the Examiner asserts. The applicant has pointed out this discrepancy to the Examiner in responses dated 24 August 2005, 30 October 2006, and 26 March 2007. However, the Examiner persists in the position that Wieloch teaches this claim feature. MPEP § 706.07 states "where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply." In the Response to Arguments section of the Final Office Action, the Examiner states "[u]pon further review, the Examiner finds the combination of Applicant's admitted prior art and Wieloch to be pertinent in that it would modify the driving means that controls the image-capturing device." *See* Final Office Action paragraph 2. This response by the Examiner does not address the Applicant's arguments and seems to have no bearing on the rejection of the claim feature, as the claim feature in dispute refers to performing compensation and calibration on a captured image, not the driving means that controls the image-capturing device. Consequently, the Examiner has not included a rebuttal of the arguments raised by the Applicant. Therefore, the Final Office Action does not comply with MPEP § 706.07.

The references do not teach the claimed features

In the Final Office Action dated 19 April 2007, the Examiner acknowledges that the admitted prior art does not teach 'determining if a calibration parameter is stored and calculating a calibration parameter if no calibration parameter is stored." *See* Final Office Action paragraph 8. However, the Examiner then proposes that Spitz (US Pat. No. 5,939,697) teaches this feature at "Col 8 Lines 19-28." *See* id. The cited portion of Spitz reads:

> A key feature of the present invention is to provide calibration parameter groups, comprised of a plurality of calibration parameter values. The calibration parameter groups may be retrieved as needed and applied to calibrate the computing and evaluation system 31, as well as one or more selected and operatively coupled scanner units 20a and/or scanning apparatus 20, to accurately scan and evaluate indicia. Again, a discussion of calibration parameter groups will be provided when referring to FIGS. 6A, 6B, and 6C.

See Spitz col. 8, lines 19-28. The cited portion of Spitz does not teach determining if a calibration parameter is stored, as the calibration parameter groups are simply 'retrieved as needed.' Further, the cited portion of Spitz does not teach calculating a calibration parameter if no calibration parameter is stored; Spitz makes no mention of what would happen if the calibration parameter was not stored. In the Response to Arguments section of the Final Office Action, the Examiner addresses this argument as follows: "[i]n Col 5 Lines 45-53, Spitz teaches wherein the calibration parameter is retrieved as needed and hence the operation can be performed if no calibration parameter is stored." *See* Final Office Action paragraph 2. However, the Examiner's argument only makes sense if the calibration parameter can be retrieved from some place other than where it is stored. But, Spitz specifically teaches that "the calibration parameter values for each system 12 may be centrally stored and retrieved from the master computer 50 as required." *See* Spitz, col. 8, lines 54-56. Consequently, Spitz teaches that the calibration parameters are retrieved from the same place where they are stored. Thus, the Examiner's response does not adequately address the Applicant's previous arguments. It should be noted that even if Spitz did teach what the Examiner proposes, it still would not meet the claimed feature, because the claim specifically refers to *calculating* a calibration parameter if one is not stored; not *retrieving* a calibration parameter. Therefore, Spitz does not teach 'determining if a calibration parameter is stored and calculating a calibration parameter if no calibration parameter is stored', as the Examiner asserts.

In the Final Office Action dated 19 April 2007, the Examiner also acknowledges that the admitted prior art does not teach "performing one or more subsequent scanning of one or more subsequent scanning objects without performing a subsequent pre-scanning calibration." *See* Final Office Action paragraph 5. However, the Examiner then proposes that Edgar (US Pat. No. 5,406,070) teaches this feature at FIG. 4. *See* id. To the contrary, Edgar specifically teaches, in the description of FIG. 4, scanning a first portion of an object, checking the light variation, either adjusting the light and rescanning the first portion of the object or scanning a second portion of the object, and repeating this process "until the whole object is scanned." *See* Edgar col. 5, lines 4-55. Therefore, Edgar does not teach 'performing one or more subsequent scanning of one or more *subsequent scanning objects* without performing a subsequent pre-scanning calibration', as the Examiner asserts.

In the Final Office Action, the Examiner further acknowledges that the admitted prior art does not teach "storing a preset calibration parameter via a control module comprising a read only memory (ROM) and using the stored calibration parameter to perform compensation and calibration for the captured image." *See* Final Office Action paragraph 6. However, the Examiner then proposes that Wieloch teaches this feature at "Col 7 Lines 52-66." *See* id. To the contrary, the cited portion of Wieloch actually describes the control scheme used in a motor controller, where the control scheme includes preset calibration parameters for the motor. *See* Wieloch col. 7, lines 52-66. As discussed above, the word 'image' or its equivalent is not found anywhere in the disclosure of Wieloch, and so Wieloch could not teach 'performing compensation and calibration of a captured image', as the Examiner asserts.

The Final Office Action does not comply with MPEP § 2141.01(a) because the Examiner is using non-analogous art to reject the claims

MPEP § 2141.01(a) states that "[i]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned" (citing *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). The present application relates to an image scanning system and a method of scanning images. *See* Application, Field of the Invention. The Examiner has used a combination with Wieloch in order to make up for the deficiency in the admitted prior art concerning calibration of a captured
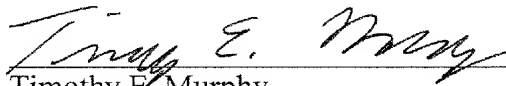
image. However, Wieloch "relates generally to the field of motor controllers" and specifically to "an adjustable frequency motor controller." *See* Wieloch, Background of the Invention. The Applicant submits that the field of motor controllers is not the field of the Applicant's endeavor (image scanning). Further, the Applicant submits that calibration of a motor or a motor controller, as in Wieloch, is not 'reasonably pertinent' to the particular problem of calibrating captured image data. Thus, Wieloch is non-analogous prior art. Therefore, the Final Office Action does not comply with MPEP § 2141.01(a).

The Applicant also asserts all arguments made previously, whether or not explicitly discussed herein, to preserve the right to assert these arguments in the Appeal Brief.

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